

energy and distal end for applying that energy to the heart wall to create a channel herein, and a channel marking and drug delivery catheter subsystem connected to an imaging medium source and a source of a therapeutic or diagnostic agent and having a distal end proximate the distal end of the treatment catheter for applying both an imaging medium and the therapeutic or diagnostic agent in or proximate the channel.

*Linhares* is directed to a system and method of marking percutaneous transmyocardial revascularization channels in a human heart. Catheter 16 of *Linhares* is only a marketing catheter which is connected only to an imaging medium source. See Col. 3, line 65 – Col. 4, line 2; Col. 4, lines 21-28; and Col. 4, lines 45-47 of *Linhares*.

The Examiner states in the Office Action that “[t]he recitation that the catheter of the present invention ‘is configured to decline therapeutic or diagnostic agent’ is an intended use and has no structural limitation.” Page 5, ¶ B of the July 29, 2003 Office Action.

However, the applicants’ claim 1 includes the feature of “a channel marking and drug delivery catheter subsystem connected to an imaging medium source and a source of a therapeutic or diagnostic agent”. Independent method claim 3 also claims introducing both an imaging medium and a therapeutic or diagnostic agent into a heart wall. This claim element is not an intended use, but a structural feature of the applicants’ claimed invention. As claimed by the applicant, the channel marking and drug delivery catheter subsystem is connected to both an imaging medium source and a source of a therapeutic or diagnostic agent. *Linhares* discloses marking catheter 16 which is connected to only one source, the source being an imaging medium source. *Linhares* clearly is only connected to one source, and does not disclose, teach or suggest connecting the marking

catheter of *Linhares* to two sources, or that the catheter is connected to a therapeutic or diagnostic agent.

Accordingly, *Linhares* fails to disclose a channel marking and drug delivery catheter subsystem connected to an imaging medium source and a source of a therapeutic or diagnostic agent as claimed by the applicant. Therefore, the applicants submit that the Examiner's double patenting and § 102(e) rejections have been overcome.

The Examiner also rejects claims 1-3 under 35 USC § 102(e) as being anticipated by U.S. Patent No. 6,023,638 to *Swenson*.

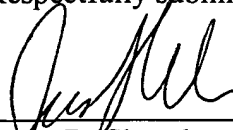
*Swenson* is directed to a system and method for conducting electrophysiological testing using high-voltage energy pulses to stun tissue. *Swenson* discloses an instrument 312 (such as a catheter or surgical probe) having an array of electrodes 318 as well as instruments 314 and 316.

However, *Swenson* fails to disclose a channel marking and drug delivery catheter subsystem having a distal end proximate the distal end of the treatment catheter. As shown in Figs. 38-39 and Col. 13, lines 9-34 of *Swenson*, there is no disclosure, teaching or suggestion that instruments 314 and 316 have a distal end proximate the distal end of the treatment catheter as claimed by the applicant.

Accordingly, as *Swenson* fails to disclose all of the features of the applicants' claimed invention, *Swenson* fails to anticipate the applicants' claims.

If for any reason this Preliminary Amendment is found to be incomplete, or if at any time it appears that a telephone conference with counsel would help advance prosecution, please telephone the undersigned or his associates, collect in Waltham, Massachusetts, (781)890-5678.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jason D. Shanske", written over a horizontal line.

Jason D. Shanske

Reg. No. 43,915